

REMARKS

(1) Summary of Office Action

Claims 1 – 20 were pending in the subject application.

Claims 1 – 12, 13 and 15 - 20 have been rejected under 35 USC 103(a) as being obvious given US Patent 6,234,677 of Mogil in view of US Patent 5,501,338 of Preston;

Claims 1 – 11, 16, 17, 19 and 20 are also rejected as being obvious under 35 USC 103(a) given US Patent 6,234,677 of Mogil in light of US Patent 5,403,095 of Melk;

Claim 14 has been rejected under 35 USC 103(a) as being obvious given US Patent 6,234,677 of Mogil in light of US Patent 5,020,921 of Beales and further in light of US Patent 5,403,095 of Melk;

Claims 3 and 4 are additionally rejected under 35 USC 103(a) as being obvious given US Patent 6,234,677 of Mogil in view of no less than five references, namely US Patent 5,501,338 of Preston; US Publication 2003/0139169 of Arreazola; US Patent 6,305,185 of Sloan; US Patent 6,216,488 of Rucker; and US Patent 5,979,175 of Ellison;

Claims 3 and 4 are additionally rejected under 35 USC 103(a) as being obvious given US Patent 6,234,677 of Mogil in view of no less than five references, namely US Patent 5,403,095 of Melk; US Publication 2003/0139169 of Arreazola; US Patent 6,305,185 of Sloan; US Patent 6,216,488 of Rucker; and US Patent 5,979,175 of Ellison;

The Applicant respectfully traverses all of these rejections, and requests that they be reconsidered and withdrawn.

(2) The Law

The Applicant notes the following legal principles:

(a) Obviousness is a question of law based on underlying factual inquiries.

The following questions of fact must be answered to resolve the issue of obviousness: the scope and content of the prior art, the differences between the claimed invention and the prior art, and the level of ordinary skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966).

(b) MPEP 2142: Establishing a *Prima Facie* Case of Obviousness

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. (*KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007)). The analysis supporting a rejection under 35 U.S.C. 103 must be explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

(c) **MPEP 2141.02: VI. Prior Art must be considered in its entirety, including disclosures that teach away from the claims**

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)

(d) **Teaching Away**

A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 16 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

(e) **MPEP 2143.01 V. The Proposed Modification cannot render the prior art unsatisfactory for its intended purpose**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

(f) **MPEP 2143.03 All Claim Limitations Must be Considered**

If an independent claim is nonobvious under 35 U.S.C. 103, any claim depending therefrom is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

(3) **Rejections Under 35 USC 103(a)**

US Patent 6,234,677 of Mogil Teaches Away

Each rejection made in the Office Action, made 'Final', of August 5, 2008 relies on US 6,234,677 of Mogil, as the principle reference. As argued in the previous response of May 5, 2008, the Applicant again respectfully submits that Mogil '677 teaches away from the presently claimed invention.

As noted above, a *prima facie* case of obviousness may always be rebutted by showing that the art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). The Mogil '677 reference teaches away from the current invention in at least one material way: namely collapsibility of the containers.

Every claim of Mogil '677 recites a "collapsible" container. Mogil '677 also teaches that when the container is not in use "the entire assembly can be folded into a collapsed position for storage" ('677 abstract). Figures 20, 21, 27 and 28 clearly illustrate a container that can be collapsed and retained in a collapsed configuration for storage. I.e., the container is movable between (a) an expanded condition (Figures 15-19 of Mogil '677) and (b) a neatly folded condition (Figures 20, 21, 27 – 31). The rigid liner of the present invention is just that: "rigid", i.e., not collapsible. It would prevent the cooler from being collapsed. Further, in addition to teaching away, since the use of a rigid liner would destroy the functionality of the Mogil reference, the rejection cannot stand given *In re Gordon*, supra.

The Applicant therefore respectfully requests that all rejections under 35 USC 103(a) that rely on US Patent 6,237,677 be reconsidered and withdrawn.

However, out of an abundance of caution, in the event that the Examiner is not persuaded by the Applicant's arguments above the Applicant has responded to each section of the present office action in detail below.

Teaching Away – Mogil '677 – Reply Commentary in Office Action

The Office Action suggests that:

"Examiner does not find this argument persuasive, as the benefits of adding a rigid liner would be especially apparent in a container which had otherwise collapsible walls, by providing additional support to the walls, and thus preventing damage to the items held in the interior. With regards to the arguments that adding a rigid liner would no longer allow the container to be collapsible, examiner notes that both rigid liners (Preston and Melk) are removable."

This argument is untenable.

With regard to the first sentence, if the teaching in the reference is that it is desirable that the cooler be collapsible, then the introduction of a rigid liner is not a benefit. On the contrary, it is a destruction of function, contrary to *In re Gordon*, supra.

The second sentence, whether true or not, is irrelevant to the issues of teaching away and destruction of function. The Office Action cites the reference for purpose of establishing a combination of features. The Examiner cannot say that the features are combined for one purpose one moment, but, for another purpose, not combined, in the

next moment. The law requires consistency of interpretation, not oscillation or peregrination.

Further, the law requires that the Examiner employ the broadest reasonable interpretation that would be made by a person of ordinary skill in the art. I.e., it has to be (a) *reasonable*; and (b) of a *person skilled in the art*. Each item of art is to be read as an whole.

The second quoted sentence relies on an interpretation of language that is far, far outside the rule of broadest *reasonable* interpretation. It implies that a person of ordinary skill in the art is to take from the reference that the tub is, first, to be installed at one moment to meet the first requirement of the claim for a rigid liner, and then, second, to be removed in the next moment to avoid destruction of function of the cited reference. It is self-evident that the mental gymnastics involved in this kind of tortured interpretation smack of impermissible hindsight analysis. This is not the reading of a *person skilled in the art* considering the references fairly and as an whole. It is the interpretation of a patent examiner. "Reasonable interpretation" does not mean using a shoehorn to push, shove or squeeze the references into the claim. That is not the test required by the law.

The reply commentary continues:

"As to applicants arguments regarding why one would use the rigid reinforcement on one portion of the cooler, but not the second, the examiner notes that nothing in applicant's claims prevents rigid liners in both portions. The second portion would still be collapsible when the liner was not in it, still reading on applicant's claims."

Again, this is clearly untenable.

First, on the contrary, the Applicant's claims do prevent such an interpretation. Claim 1 clearly requires that the second portion be "movable between a first, folded position and a second, unfolded position..." If a rigid liner is installed in the second portion, then this portion of the claim cannot be satisfied. It also requires an interpretation that (a) goes against the teaching of the principle reference; and (b) requires destruction of function of the principle reference, both contrary to law.

Second, even disregarding the issues of teaching away and destruction of function, the rationale of the rejection is utterly arbitrary. It implies that a person skilled in the art would understand why to insert a rigid liner in one container, but, at the same time, for no objectively discernible reason, would also understand the art to indicate that no rigid liner should be used in the other container. Where is the objective reason for doing this? Again, the stark artificiality, the arbitrariness, of the rationale is a vivid demonstration that this rejection is the product of an impermissible hindsight analysis, contrary to law.

The Applicant respectfully submits that (a) the Commissioner bears the burden of establishing grounds for rejection; and (b) nothing in either of the Office Action provides an objective showing that so much as a single person of any level of skill in the art would make the quite remarkable interpretations of the references put forth as bases for rejection, and in the response commentary quoted above. As such, the Commissioner has not established a basis for the rejection according to law.

All rejections based on obviousness are necessarily exercises in fiction. The point of requiring an explicit, clearly established objectively determinable reason for making the combination of modification, as required by *KSR*, and *Graham* before it, is to

prevent impermissible hindsight analyses that would otherwise capriciously deprive the Applicant of the commercial value of his invention. The objectively unsupported rationales advanced in the Office Actions to date are precisely what the law has long sought to avoid.

Commercial Context

What seems to have been lost in these rejections is the commercial reality underlying the Applicant's claims. The Applicant reminds the Commissioner that the effect of the rejection, if upheld, is to deprive the Applicant of valuable commercial property, on the basis of a tortured, (in the Applicant's view untenable), interpretation of references. The Applicant is making rather modest claims, entirely commensurate with the invention. The Applicant is not claiming the Moon. While the Commissioner may be unable to discern the merits of the invention, competitors may be only too ready to conclude otherwise. The claims correspond to commercial products of the owner of the application, and are nothing more than that to which an entity in this industry might reasonably and fairly expect itself to be entitled. The Applicant respectfully submits that the effective *de facto* confiscation of the application owner's property on the basis of strained interpretation cannot have been intended by the Supreme Court in *KSR*.

In that connection, the Applicant explicitly reserves the right, without prejudice, to submit other evidence, whether evidence of commercial success or any other evidence, to demonstrate that the Applicant has sold products according to the current claims, at such future time as may be appropriate, in conformity with and to the law pertaining to

continuation, division, and requests for continued examination as were in force at the time of filing of this application.

The Applicant again traverses the rejections, and requests that they be reconsidered and withdrawn.

Rejection of Claims 1-12, 13 and 15-20: The Preston Reference

At section 1 of the office action, the Examiner rejected claims 1-12, 13 and 15-20 under 35 U.S.C. 103(a) as being unpatentable over Mogil '677 in view of US Patent 5,501,338 of Preston.

Section 1 of the Office Action begins by listing claimed features allegedly disclosed by Mogil '677. The office action states that Mogil '677 teaches all the claimed limitations except for the reinforcement member, and that the '338 Preston reference discloses a reinforcement member in the form of a plastic bucket. Having merely recited the elements disclosed by Mogil '677 and '338 Preston, the Examiner concludes "therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to create the assembly of Mogil '677 with the reinforcement member and dividers of Preston..."

Absent further clarification or discussion by the Examiner, the Applicant faces the bald conclusory assertion that "it would have been obvious" to combine the references. The Applicant directs the Examiner's attention to the law set by the Supreme Court in *KSR* that any rejection under 35 U.S.C. 103 "cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness." KSR, 550 U.S. at ___, 82 USPQ2d at 1396.

The Applicant submits that the Examiner's rejections under 35 U.S.C. 103(a) are improper on the grounds that the Examiner has failed to provide the reasoning and rationale necessary to support the legal conclusion of obviousness as required under KSR. Rather, the rejection community is merely conclusory, as expressly forbidden by KSR.

Office Action does not Answer Applicant's Points

As noted above, in responding to the Applicant, the Examiner states, at section 6 of the office action, "the *benefits* of a rigid liner would be especially apparent in a container which had otherwise collapsible walls, and thus prevent damage to the items held in the interior". (Emphasis added.) As noted above, if collapsibility is a desired function, destruction of that functionality is not a benefit. The Applicant again respectfully submits that this response does not remedy the shortcomings of the Examiner's rejection as described above. If anything, the Applicant submits that this rationale is incompatible with the operation of the Mogil '677 reference, contrary to, *In re Gordon*.

The Applicant respectfully submits that the Examiner has not demonstrated any objective reason why a person skilled in the art would combine the teachings of Mogil '677 and Preston to arrive at the claimed invention. Accordingly, the Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 16 and the related rejections of claims 1-12, 13, 15 and 17-20 that depend therefrom (see

(f) above and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Previous Arguments Re-iterated

In addition, the Applicant reiterates its arguments filed on May 5, 2008 that are not addressed in the present final office action. Specifically that the '338 Preston reference fails to disclose a folding container portion. In its response of May 5, 2008, the Applicant stated:

“As a starting point, the Applicant notes that Preston does not teach a folding container portion of any kind. On the contrary, Preston teaches the use of multiple rigid food tray assemblies inside a thermally insulative cover (at page 12); and

Further, the principle reference teaches a folded liner – over and over and over. The Applicant fails to see how or why a person of ordinary skill in the art would them be led, seemingly rather perversely, to use a rigid liner instead, apparently in defiance of the plain teaching of the reference. Clearly the proposed use of a rigid liner instead runs directly opposite to the teaching of that reference.

In summary, if the rejection is correct, a person skilled in the art would take the rigid liner of Preston, and insert it into one of the portions of the principle reference, even though the resulting structure would (a) make at least one of the collapsible portions no longer collapsible; (b) dispense with the folded liner (or, alternatively, render it redundant – why have both a folded liner and a rigid liner); and (c) no longer fall within the claims of the principle reference (i.e., would make the apparatus no longer suitable for its purpose).

The Applicant respectfully submits that it is unable to see how or why a person skilled in the art would do such a thing, when it is contrary to the thrust of the entire disclosure of the principle reference. The Applicant respectfully submits that the proposed combination would appear

necessarily to destroy the claimed invention of the principle reference. As such there can be no reason to make the combination or modification (See: *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)) (at page 13)."

For these reasons, the Applicant respectfully requests that the rejection of independent claims 1 and 16 and the related rejections of dependent claims 2-12, 13, 15 and 17-20 be reconsidered and withdrawn.

Rejection of Claims 1-12, 13 and 15-20: The Melk Reference

Regarding the Examiner's rejections of claims 1-12, 13 and 15-20 as being unpatentable over Mogil '677 in view of U.S. Patent 5,403,095 of Melk, the Applicant respectfully submits that these rejections suffer from the same problems as the rejections based on the combination of Mogil '677 and Preston.

In combining the teachings of Mogil '677 with the teachings of Melk to arrive at the claimed invention, the Examiner appears simply to have exchanged a plastic bucket taught by Preston with a plastic bucket taught by Melk. Accordingly, for reasons analogous to those explained above in reference to Preston, the Applicant respectfully submits that:

- (a) the Office Actions have failed to articulate any objective logical reason why a person skilled in the art would insert a rigid container into an insulated container that is operable to collapse for storage, thereby destroying the functionality of the latter;
- (b) the Mogil '677 reference teaches away from the non-collapsibility that would result from incorporation of the Melk bucket; contrary to *In re Geisler*, supra; and

(c) incorporation of the rigid bucket of Melk would destroy the collapsible functionality of Mogil '677, contrary to *In re Gordon*, supra.

For these reasons, the Applicant respectfully requests that the rejection of independent claims 1 and 16 and the related rejections of dependent claims 2-12, 13, 15 and 17-20 be reconsidered and withdrawn.

Rejection of Claim 14: The Beales Reference

Claim 14 has been rejected on the basis of a combination of the '677 Mogil in view of '095 Melk and further in view of U.S. Patent 5,020,921 of Beales.

Specifically, at section 3 of the present office action, the Examiner states that the combined teachings of Mogil '677 and Melk teach all the features of claim 14 except a folding divider member that is taught by Beales.

For reasons analogous to those explained above in the context of claims 1-12, 13 and 15-20, the Applicant submits that the combination of these references is contrary to the law as required by KSR, supra, because there has been no articulation of any objective logical reason why a person skilled in the art would combine the teachings of the cited references. Accordingly, the Applicant respectfully requests that the rejection of claim 14 be reconsidered and withdrawn.

Further, the Applicant respectfully submits that the addition of the divider taught in Beales is not a "folding divider" as claimed in claim 14, and that the Beales itself teaches away from the claimed invention. As noted in the response of May 5, 2008, while the divider taught by Beales may be assembled by folding, once assembled it is not foldable or collapsible because the partitions "become locked, by virtue of a locking

tab carried thereby becoming engaged with a respective locking aperture." (Beales abstract)

In response to the Applicant's arguments, at section 8 of the present office action, the Examiner replied that "unlocking the tabs is a simple matter of pulling the locking piece out of the slot". Respectfully, the Applicant submits that there is nothing in the Beales reference to support the Examiner's assertion that the assembled divider is expected to be, or can be, unlocked and re-folded. On the contrary, the Applicant submits that the Beales reference, when read as a whole as required by the court in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984), suggests that the divider is not re-foldable, or even reusable.

The teachings of Beales are directed to a paperboard divider that is to be used to support items in a paper bag (Beales abstract). The innovation claimed by Beales appears to be the fact that the divider is formed from a single paperboard blank, not that the divider is re-foldable. The fact that the divider is formed from paperboard and is intended for use within a disposable paper bag leads to the conclusion that a person skilled in the art would understand that divider itself is also disposable. The Applicant submits that a disposable divider need not be designed to be re-foldable as suggested by the Examiner.

Destruction of Function

The Applicant submits that attempting to remove a paperboard "locking tab" from a mating paperboard "locking aperture" by force may tend irreparably to damage the

tab, the aperture or both, leading to inoperability of the device. The Applicant submits that inasmuch as operation of the divider in the manner described by the Examiner may lead to the destruction of the divider it would not be obvious to one skilled in the art to combine the divider taught by Beales with the teachings of Mogil '677 and Melk to arrive at the claimed invention.

Further, a person of ordinary skill in the art would not reasonably be led to make the proposed combination of Beales with the combined teachings of Mogil '677 and Melk because it implies use of a paperboard divider in a container of liquid.

That is, Mogil '677 teaches a soft-sided cooler that can contain liquids (Mogil '677 column 9, lines 11-25), and Mogil '677 is also clear that internal partitions of the cooler are designed to be water impermeable (Mogil '677 column 12, lines 58-60). Beales clearly intends the divider to be formed from paperboard. Beales makes numerous references to paperboard, the disposable nature of the product lends itself to being formed from paperboard, no alternative materials are discussed or disclosed in the description, and every independent claim refers to a "paperboard" product. It is a matter of common experience that paperboard soaks up water, and thereafter tends to become soft, weak and fragile, thus ceasing to be useful for its purpose. Therefore, for the practical reasons described above, the Applicant submits that a person skilled in the art would not be motivated to combine the paperboard divider of Beales with the cooler of '677 Mogil. Under *In re Gordon*, incompatibility of this nature rebuts an obviousness finding.

Rejection of Claims 3 and 4: The Rigid Cooler References

At section 4 of the present office action, claims 3 and 4 are additionally rejected on the basis of the combination of Mogil '677 and Preston in view of no less than four other references, namely 2003/0139169 Arreazola, U.S. 6,305,185 of Sloan, U.S. 6,216,488 of Rucker, and U.S. 5,979,175 of Ellison.

As discussed above, the Applicant respectfully submits that a person skilled in the art would not reasonably combine the teachings of Mogil '677 and Preston to arrive at the invention as claimed in claim 1. Therefore, according to the law as set out in *In re Fine*, above, dependent claims 3 and 4 must also be found nonobvious. The Applicant therefore respectfully requests that the rejections of claims 3 and 4 be reconsidered and withdrawn.

Further, the Applicant also repeats the arguments previously made in the response of May 5, 2008, that a pen cannot properly be considered "an entertainment" device requiring an access port for an electrical connection. In the present office action (at section 9), the Examiner suggests that a pen is an entertainment device and that "if one had a pen which required an electrical connection, the opening would constitute an access port". However, the does not provide any reference that teaches an electrical pen, and the Applicant is not aware of any such device. The Applicant respectfully requests that this ground of rejection be reconsidered and withdrawn.

The Applicant also notes that claims 3 and 4 are rejected at section 5 of the present office action using the same combination of references, with the Melk reference substituted for Preston. Therefore, the Applicant respectfully requests that the

rejections under section 5 of the current office action be reconsidered and withdrawn for reasons analogous to those described above.

(4) **Conclusion**

In view of the foregoing arguments the Applicant again submits that the claims pending in this case are presently in a condition for allowance. Therefore the Applicant requests early and favourable disposition of this application.

Applicant respectfully submits that this application is in condition for allowance and such action is earnestly solicited. If the Examiner believes that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below to schedule a personal or telephone interview to discuss any remaining issues.

In the event that this paper is not being timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account Number 01-2300, referencing Docket Number 024643-00015.

Respectfully submitted,



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